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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,257	04/12/2001	Franz-Marcus Nowak	10533/3	5012
757	7590	07/28/2006	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			NGUYEN, TAI T	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/835,257

Applicant(s)

NOWAK, FRANZ-MARCUS

Examiner

Tai T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12, 13, 15, 17 and 24 is/are rejected.
- 7) ☒ Claim(s) 10, 11, 14, 16 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/07/01</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 1-18 in the reply filed on 10/11/04 is acknowledged.

Applicant has added new claim 24, thus claims 1-18 and 24 being exam in this office action.

### ***Specification***

2. The disclosure is objected to because of the following informalities: the function of "speed synthesizer 134 and closed captioning circuit 136" have not been disclosed but claimed in claims 10 and 11.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 24 recites the limitation "the user interface" in line 4. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 3-5, 8-9, 13, 15, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith Dewey (US 6,229,430).

Regarding claims 1 and 17, Smith Dewey discloses a system for providing a multi-media alarm, comprising:

- a publicity accessible network (114, figure 1);
- a user interface (102) in communication with the publicity accessible network (figure 1, col. 3, lines 1-28); and
- a hand-held timing device in the form of a computer (100) in communication with the user interface, the timing device being configured to track a universal time and harvest a user selected media that is played in a programmed order with a selected

commercial media at a user determined time through the hand-held timing device (figure 1, col. 3, line 29 through col. 4, line 14).

Regarding claims 3-4, Smith Dewey discloses a transceiver interface (110, figure 1), wherein the transceiver being tuned to receive a broadcast containing a coordinated universal time signal.

Regarding claim 5, as shown in figure 1, Smith Dewey discloses the timing device and the transceiver are being a unitary device.

Regarding claim 8, Smith Dewey discloses a Host Site (118, 120) in communication with the publicly accessible network, wherein the Host Site is configured to combine the user's selected media with the commercial selected media while downloading the user selected media with the commercial selected media into the timing device (figure 1).

Regarding claim 9, Smith Dewey discloses a Host Site interfaced to the publicly accessible network, wherein the Host Site and the timing device are configured to program the time and an alarm in the timing device (col. 3, lines 29-45).

Regarding claim 13, Smith Dewey discloses the timing device being configure to access a commercial provider (120, figure 1).

Regarding claim 15, Smith Dewey discloses the harvested media being stored in a memory (108, col. 3, lines 57-65).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 6-7, 12, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith Dewey (6,229,430) in view of Herold (US 5,832,067).

Regarding claim 2, Smith Dewey discloses the media comprises an audio content (col. 4, lines 4-9) but fails to disclose the media comprises a video content. Herold teaches the use of playing a selected media comprising audio and video content (figure 5, col. 5, line 60 through col. 6, line 27). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the video content as taught by Herold in the system as disclosed by Smith Dewey for the purpose of providing both audio and video to the user upon user's selection.

Regarding claims 6-7, Smith Dewey discloses an audio output (124, figure 1), Smith Dewey discloses the instant claimed invention except for a display that plays the user and the commercial selected media, the output and the display being a unitary part of the timing device. Herold teaches an audio out put (234) and a display (274) those being a unitary of the timing device (figure 5). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the output and the display as a unitary of the timing device as taught by Herold in the

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system as disclosed by Smith Dewey for the purpose of facilitating a user to enhance the output upon user's selected.

Regarding claim 12, Smith Dewey discloses the instant claimed invention except for the timing device comprising an atomic clock. Herold teaches the use of an atomic clock (250, figure 5).

Regarding claim 24, refer to claims 1-2 and 8 above.

### ***Allowable Subject Matter***

10. Claims 10-11, 14, 16 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Treyz et al. (US 6,678,215).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tai T. Nguyen whose telephone number is (571) 272-2961. The examiner can normally be reached on Monday-Friday from 7:30am-5:00pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel J. Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



TAI NGUYEN  
PRIMARY EXAMINER  
Tai T. Nguyen  
Primary Examiner  
Art Unit 2612

July 25, 2006